

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. 14920US01

In the Application of:

Anand Pande
U.S. Serial No.: 10/692,957
Filed: October 24, 2003
For: SYSTEM AND METHOD FOR
DESIGNING DATA STRUCTURES
Examiner: Richard B. Franklin
Group Art Unit: 2181
Confirmation No.: 2011

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I hereby certify that this correspondence is being transmitted via EFS-Web to the United States Patent and Trademark Office on October 1, 2007.

/Michael T. Cruz/
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REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is a Reply Brief in response to the Examiner's Answer mailed July 30, 2007. The deadline by which to file a Reply Brief is Monday, October 1, 2007 since September 30, 2007 falls on a Sunday.

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RESPONSE TO EXAMINER'S ANSWER

Pontius in view of Yi

Claims 1-4, 12, 13, 16, 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being obvious over Pontius in view of Yi. It is respectfully requested that the Board reverse the rejection for at least the reasons as set forth below.

With respect to claim 1-4, 12, 13, 16, 23 and 24, the Examiner has attempted to allege a *prima facie* case of obviousness as set forth in the Office Action Made Final mailed May 5, 2006 ("Office Action Made Final").

In response to the alleged *prima facie* case of obviousness, Appellant has presented rebuttal evidence and arguments that rebut the Examiner's *prima facie* case of obviousness. See, e.g., Revised Appeal Brief of April 27, 2007 ("Revised Appeal Brief") at pages 4-13.

However, in response to Appellant's presented rebuttal evidence and arguments, the Examiner mistakenly applied *In re Keller* and the Examiner merely restated the previously alleged (and now rebutted) *prima facie* case of obviousness.

In other words, the Examiner has failed to substantively address Appellant's rebuttal evidence and arguments as set forth, for example, in the Revised Appeal Brief at pages 4-13. Even if *In re Keller* is applicable, which Appellant's respectfully challenges, the Examiner has failed to apply the facts of *In re Keller* to Appellant's rebuttal evidence and arguments as set forth, for example, in the Revised Appeal Brief at pages 4-13.

It is respectfully requested that the Examiner address factually and substantively the rebuttal evidence and arguments as set forth, for example, in the Revised Appeal Brief at pages 4-13.

Appellant respectfully submits that *In re Keller* has been misapplied. *In re Keller* is cited in the M.P.E.P. § 2145(III) in the section titled "ARGUING THAT PRIOR ART DEVICES ARE NOT PHYSICALLY COMBINABLE". In other words, *In re Keller* is applicable to a case in which an appellant argues that two references are not physically combinable.

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Appellant's rebuttal evidence and arguments as set forth, for example, in the Revised Appeal Brief at pages 4-13 do not relate to whether a device in Yi is *physically combinable* with a device in Pontius.

Appellant respectfully draws the attention of the Examiner and the Board to M.P.E.P. § 2145(III) in which the Board can plainly see the Examiner's *In re Keller* boilerplate which the Examiner reproduced in the Examiner's Answer at page 9.

The Examiner failed to disclose that, **in the very next paragraph** after the *In re Keller* boilerplate, M.P.E.P. § 2145(III) states: "However, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP § 2143.01." (underlining added).

The attention of the Board and the Examiner is respectfully drawn to Appellant's rebuttal evidence and arguments as set forth, for example, in the Revised Appeal Brief at pages 4-13, which focuses on M.P.E.P. § 2143.01(V) ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification").

Thus, even if *In re Keller* were applicable (and Appellant strongly believes that it is not applicable), M.P.E.P. § 2145(III) clearly states that M.P.E.P. § 2143.01(V) trumps *In re Keller*. Again, the Board and the Examiner are respectfully requested to carefully peruse the very next paragraph in M.P.E.P. § 2145(III) after the Examiner's *In re Keller* boilerplate.

Furthermore, the Examiner's merely repeating the alleged (and now rebutted) *prima facie* case of obviousness is not a rebuttal to Appellant's evidence and arguments as set forth, for example, in the Revised Appeal Brief at pages 4-13, which focuses on M.P.E.P. § 2143.01(V).

For at least the above reasons, Appellant's rebuttal evidence and arguments have gone unchallenged by the Examiner in the Examiner's Answer.

It is respectfully requested that the Board reverse all obviousness rejections based on Pontius in view of Yi.

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Pontius in view of Yi and further in view of Miyamoto

Claims 5-11, 14, 15 and 17-19 stand rejected under 35 U.S.C. § 103(a) as being obvious over Pontius in view of Yi and further in view of Miyamoto. It is respectfully requested that the Board reverse the rejection for at least the reasons as set forth below.

Since claims 5-11, 14, 15 and 17-19 stand rejected under 35 U.S.C. § 103(a) as being obvious over, at least in part, Pontius in view of Yi, the Examiner must address all of Appellant's rebuttal evidence and arguments made above and in Appellant's Revised Appeal Brief at pages 4-13.

In addition, with respect to the rejection of claim 5-11, 14, 15 and 17-19 with respect to Pontius, Yi and Miyamoto, Appellant has presented ***additional*** rebuttal evidence and arguments in the Revised Appeal Brief at pages 13-17.

In Appellant's additional rebuttal evidence and arguments as set forth in the Revised Appeal Brief at pages 13-17, Appellant has focused on evidence that Pontius, Yi and Miyamoto teach away from each other. According to M.P.E.P. § 2145(X)(D)(2), it is improper to combine references where the references teach away from their combination. Appellant presented substantial evidence that Pontius, Yi and Miyamoto were improperly combined because the references teach away from their combination.

In response to the additional rebuttal evidence and arguments in the Revised Appeal Brief at pages 13-17, the Examiner has attempted to merely allege, yet again, the (rebutted) *prima facie* case of obviousness as set forth in the Office Action Made Final.

In other words, Appellant has presented additional evidence and arguments that rebut the Examiner's alleged *prima facie* case of obviousness. In response to the additional evidence and arguments, the Examiner has chosen not to address any of the additional evidence and arguments presented by Appellant, but has chosen instead to merely repeat the alleged (and rebutted) *prima facie* case of obviousness.

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It is respectfully submitted that the Examiner's mere recycling of the rebutted *prima facie* case of obviousness is not a rebuttal to Appellant's evidence and arguments as set forth, for example, in the Revised Appeal Brief at pages 4-13 and Appellant's additional evidence and arguments as set forth, for example, in the Revised Appeal Brief at pages 13-17.

For at least the above reasons, Appellant's rebuttal evidence and arguments have gone unchallenged by the Examiner in the Examiner's Answer.

It is respectfully requested that the Board reverse all obviousness rejections based on Pontius in view of Yi and further in view of Miyamoto.

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Conclusion

It is respectfully submitted that the Examiner's Answer, in general, appears devoid of substantive analysis with regard to Appellant's rebuttal evidence and arguments as set forth in Appellant's Revised Appeal Brief at pages 4-13 and with regard to Appellant's additional rebuttal evidence and arguments as set forth in Appellant's Revised Appeal Brief at pages 13-17.

Instead, it appears the Examiner's Answer misapplies boilerplate and merely reproduces the already rebutted *prima facie* case of obviousness.

For the foregoing reasons, it is believed that claims 1-19, 23 and 24 are patentable over the alleged prior art of record. Reversal of the Examiner's rejection of claims 1-19, 23 and 24 is therefore respectfully requested, thereby placing claims 1-19, 23 and 24 in condition for allowance. Accordingly, issuance of a patent on the application is therefore respectfully requested.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: October 1, 2007

Respectfully submitted,

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